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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Confirmation No.: 9987

Nemoto HIROTOMI

Art Unit: 3632

Serial No.: 10/784,891

Examiner: Todd M. Epps

Filed: February 24, 2004

Docket No.: 107348-00393

For: ANTI-VIBRATION SUPPORT SYSTEM FOR ENGINE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

August 8, 2007

Sir:

The Applicant requests review of the Office Action mailed March 8, 2007, in the patent application identified above. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

REMARKS

Claims 1-20 are pending in the subject application. The outstanding Office Action is a Final Office Action. Thus, the application qualifies for Appeal.

In the outstanding Office Action, the Examiner rejected claims 1-10 and 11-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,422,546 B1 to Nemoto et al. (hereinafter "Nemoto") in view of U.S. Patent No. 6,406,010 to Yano et al. (hereinafter "Yano").

The Applicant submits that these rejections are made in error for at least the reasons set forth below.

I. Essential Element(s) Omitted for Prima Facie Obviousness Rejection

The outstanding Office Action cites and applies references that, alone and in any combination thereof, fail to teach or suggest each and every feature recited by the pending claims. It is well known that under U.S. patent practice, to establish prima facie obviousness of a claimed invention, all claim features must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA). "All words in a claim must be considered in judging the patentability of that claim against the prior art." See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. See *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). M.P.E.P. §2143.03

The following comments set forth the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

As in the Office Action mailed March 8, 2007, in the outstanding final Office Action mailed June 6, 2007, the Examiner asserts that Yano discloses the feature wherein operation of said active anti-vibration supporting device is prohibited when an abnormality in an operational state of the engine is detected, as recited in claim 1, and the feature wherein cylinder suspension of the engine is prohibited when an abnormality in an operational state of said active anti-vibration supporting device is detected, as recited in claim 11.

In making the rejections, the Examiner admits that Nemoto fails to teach wherein an active anti-vibration supporting device is prohibited when an abnormality in an

operational state of the engine is detected, as recited in claim 1, and wherein a cylinder suspension of the engine is prohibited when an abnormality in an operational state of an active anti-vibration supporting device is detected, as recited in claim 11. See *Office Action of March 8, 2007, at page 3, lines 7-9 and page 4, lines 15-18*.

Yano was cited in the Office Actions of September 7, 2006, and March 8, 2007, as allegedly curing the deficiencies that exist in Nemoto.

It is noted that in the September 7, 2006, Office Action, with regard to claims 1-10, the Examiner stated, "Nemoto '546 discloses the previous invention failing to specifically teach wherein an active anti-vibration supporting device is prohibited when an abnormality in an operational state of the engine is detected. Nevertheless, Yano '010 discloses wherein the vibration supporting device is prohibited when an abnormality in an operational state of the engine is detected." *Office Action of September 7, 2006, page 3, lines 7-11*. In addition, in the September 7, 2006, Office Action, with regard to claims 11-20, the Examiner stated, "[h]owever, Nemoto '546 discloses the previous invention failing to specifically teach wherein a cylinder suspension of the engine is prohibited when an abnormality in an operational state of an active anti-vibration supporting device is detected. Nevertheless, Yano '010 discloses wherein the vibration supporting device is prohibited when an abnormality in an operational state of the engine is detected." *Office Action of September 7, 2006, page 4, lines 17-21*.

However, as was noted in the response to the September 7, 2006, Office Action, thorough review of the Yano reference yielded no support for the Examiner's allegation.

In the Office Action dated March 8, 2007, the Examiner reiterated the above assertions (see *Office Action of March 8, 2007 at p. 3, lines 7-11 and p. 4, lines 15-19*), added that attention is directed to "Yano '010 reference [sic], column 16, lines 7-25, wherein a control device is employed to control the supply of electric current, so that the electric current has a frequency and an amplitude corresponding to those of vibration to be damped. For example an acceleration sensor is employed to detect directly the vibration of vehicle's body to be damped, and supply an electric signal representing the detected vibration, to the control device, or a signal such as a crank-angle signal or an ignition pulse signal, that relates to the vibration of vehicle's body to be damped is

supplied to the control device. In this case, Yano '010 used the concept of having a sensor used on engine [sic] (in any form) to be able to help when an abnormality in an operational state of the engine is detected. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the support system of Nemoto '546 with a sensor to detect an abnormality in an operational state of the engine as taught by Yano '010 wherein doing so would provide thereof [sic] to shut off the engine and to prevent further damaged [sic] to the engine when an abnormality of the engine is detected." *Office Action of March 8, 2007, at p. 5, line 5 – p. 6, line 6, emphasis added.*

However, as noted in the Pre-Appeal Brief filed April 19, 2006, neither claim 1 nor claim 11 recites shutting off the engine. Moreover, at column 16, lines 7-25, Yano discloses:

A current-supply control device (not shown) is employed to control the supply of electric current to the coils 94, 96 of the coil member 88, so that the electric current has a frequency and an amplitude corresponding to those of vibration to be damped, and has an appropriate angular phase. To this end, for example, an acceleration sensor is employed to detect directly the vibration of vehicle's body to be damped, and supply an electric signal representing the detected vibration, to the control device; or a reference signal, such as a crank-angle signal or an ignition pulse signal, that relates to the vibration of vehicle's body to be damped is supplied to the control device. The control device may be adapted to determine a phase and an amplitude of the electric current based on a relationship (e.g., a data map obtained in advance from experiments) between the phase or amplitude and one or more appropriate reference factors such as rotation number or acceleration of the engine, shift position, and/or temperature. The current-supply control device can utilize an adaptive control including a feedback circuit.

Clearly, the cited portion of Yano above neither discloses nor suggests prohibiting an active anti-vibration supporting device when an abnormality in an operational state of the engine is detected, as recited in claim 1, or prohibiting cylinder suspension of an engine when an abnormality in an operational state of an active anti-vibration supporting device is detected, as recited in claim 11. Moreover, as noted in

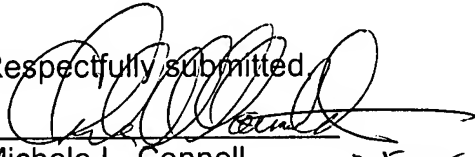
the response to the September 7, 2006 Office Action, and in the telephonic interview held with the Examiner on June 18, 2007, there is no mention whatsoever anywhere in Yano of prohibiting an active anti-vibration supporting device when an abnormality in an operational state of the engine is detected, as recited in claim 1, or of prohibiting cylinder suspension of the engine when an abnormality in an operational state of an active anti-vibration supporting device is detected, as recited in claim 11.

The Applicant respectfully submits that the Examiner's assertion that Yano discloses, let alone suggests, the aforementioned features is an error based upon a clear factual deficiency in the rejection, and not a matter of interpretation. For at least this reason, the Applicant respectfully submits that the rejections based on the combination of Nemoto and Yano are improper, and withdrawal of the rejections is respectfully requested. For further arguments regarding the rejections, please see the Response filed December 7, 2006.

Conclusion

For all of the above reasons, review of the outstanding Office Action is respectfully requested, and a favorable decision, and allowance of all pending claims, are earnestly solicited.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Docket No. 107348-00393.**

Respectfully submitted,

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Enclosures: Notice of Appeal to the BPAI ; Petition for Extension of Time; and
Pre-Appeal Brief Request for Review (Form PTO/SB/33)